

which now includes claims 1-6, 8-18, 20-29, 31-34 and 37-45. Additionally, original Group III becomes New Group II (claim 30), and original Groups IV and V are rejoined into New Group III, which now includes claims 35, 36 and 46.

II. Restriction

Citing 35 U.S.C. §§121 and 372, the examiner alleges that claims 1-6, 8-18 and 20-46 are directed to the following three distinct inventions:

- Group I. Claims 1-6, 8-18, 20-29, 31-34 and 37-45 are directed to a nucleic acid sequence for enhancing expression of a useful gene, comprising nucleotide sequence of SEQ ID NOS:1 and 7, vector, host cell, method of producing a useful gene product, and probe for screening substances;
- Group II. Claim 30 is directed to a method of expressing useful gene product;
- Group III. Claims 35, 36 and 46 are directed to a therapeutic composition comprising the nucleic acid sequence of SEQ ID NOS:1 and 7.

III. Election

The applicants hereby elect Group I, which includes Claims 1-6, 8-18, 20-29, 31-34, and 37-45 directed to nucleic acid sequence for enhancing expression of a useful gene, comprising nucleotide sequence of SEQ ID NOS:1 and 7, vector, host cell, method of producing a useful gene and probe for screening substances, with traverse (see below).

IV. Applicants Traverse the Restriction.

A. Applicants Traverse the Restriction between Groups I and III.

The applicants request examination of the claims of Groups I and III together because the inventions cited by examiner as representative of Groups I and III are related inventions and examination of all claims comprising these groups would not constitute an undue burden to the Patent Office

The claims of Group I are directed to nucleic acid sequences for enhancing expression of a useful gene, comprising SEQ ID NOS: 1 and 7, and vector, host cell, method of producing

a useful gene product, and probe for screening substances. The special technical feature of the invention of Group I is the 5'-untranslated region of a viral gene for enhancing expression of a useful gene and comprises both SEQ ID NO:1 and SEQ ID NO:7. The invention of Group III is a therapeutic composition for treating diseases comprising the nucleic acid sequence of SEQ ID NOS:1 and 7. The claims of Group III are directed to a therapeutic composition comprising the nucleic acid sequence for enhancing expression of a useful gene according to claims that are representative of the invention of Group I. The examiner concedes that Group III shares the same technical feature as Group I, but restricts the two groups on the rationale that the nucleic acids, (Group I) are claimed in their variant forms represented by deletions, substitutions and insertions, i.e., lack one-to-one correspondence with the methods of using them (Group III). The applicants respectfully point out to the examiner that the claims of Group III are directed to a therapeutic composition, which comprise the nucleic acid sequences of Group I. Therefore, the applicants submit that the examiner has failed to point out any basis for stating that the two groups lack one-to-one correspondence.

Accordingly, applicants request that claims of Group I and Group III be examined together.

B. Applicants Traverse the Restriction between Groups I and II.

The applicants request examination of the claims of Groups I and II together because the inventions cited by examiner as representative of Groups I and II are related inventions and examination of all claims comprising these groups would not constitute an undue burden to the Patent Office.

The invention of Group II (claim 30) is directed to a method of expressing useful gene product using the vector of claim 28, which is the invention of Group I. It is evident that the special technical feature of Group II is the same as Group I, the nucleic acid sequences of Group I. The examiner has stated the reason for the restriction as a lack of one-to-one correspondence but fails to cite the reason for such conclusion. The applicants maintain that these two inventions are related and are not materially different as suggested by the examiner. Accordingly, applicants request that claims of Group I and Group III be examined together.

V. Rejoinder

In the event that the restriction requirement and election is maintained, the applicants,

under MPEP §821.04, request rejoinder of claims of Groups II and III upon allowance of the product claims of Group I. The method claims of Group II depend from and include all the limitations of the allowable product claims (Group I). Furthermore, the claims of Group III also depend from and include all the limitations of the claims of Group I. As such, the applicants request rejoinder of the claims of Group III upon a notice of allowability of the claims of Group I.

VI. Conclusion

In view of the foregoing, the applicants submit that they have properly responded to the outstanding restriction requirement. Should the examiner have any questions or concerns regarding this response or the application, she is invited to contact the undersigned at the number indicated.

Respectfully submitted,

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